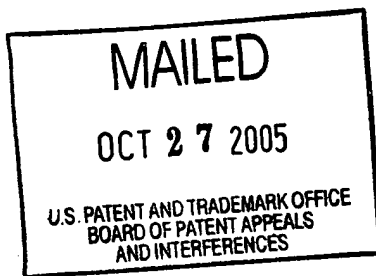


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITES STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte STEVE MORSA

Appeal No. 2005-2482
Application 09/832,440

ON BRIEF

Before RUGGIERO, MACDONALD, AND NAPPI, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

- I. Whether a rejection of claims 81, 82, 87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, and 148-158 is appropriate.
- II. Whether the rejection of claims 1, 80, 164, and 176 erroneously states that the “College Board fails to expressly disclose means for inputting into said system benefit information from two or more distinctly different benefit classes/categories.”
- III. Whether the rejection of claims 1, 80, 164, and 176 is a new ground of rejection.
- IV. Whether the Examiner needs to more fully address each of the points raised by Appellant in the brief and reply brief.

I. Whether A Rejection Of Claims 81, 82, 87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, and 148-158 Is Appropriate.

We have reviewed the Examiner's answer and find no rejection of these claims. Nor does the record indicate that these claims are allowable. Therefore, we request that the Examiner take appropriate steps to address this issue. We note that Appellant raises this issue at page 4 of the reply brief and the Examiner has failed to address the issue.

Accordingly, we *remand* for consideration of this issue

II. Whether the rejection of claims 1, 80, 164, and 176 erroneously states that the "College Board fails to expressly disclose means for inputting into said system benefit information from two or more distinctly different benefit classes/categories."

The Examiner repeatedly states that this feature is missing from the reference. However, page 18 of the College Board reference clearly teaches "research grants, loans, and internships." While one might arguably consider grants and loans to be within the same class/category, such is not the case with internships. Appellant's specification at page 13 specifically states that housing, education, medical, travel, and employment are different classes or categories. Given that internships can reasonably be viewed as a form of employment, plural different benefit classes/categories are taught by the College Board reference. The record before us does not mention nor address this in any way.

We also note that distinctness as to different classes or categories is highly subjective (in the eye of the beholder) and not based on objective criteria (such as physical structure). An

artisan may reasonably view grants and loans as distinctly different classes or categories. The record before us does not mention nor address this in any way.

Finally, the Examiner states at page 6 of the answer that the College Board reference teaches “3 different types.” Then the rejection indicates that classes/categories are not taught. This is a contradiction given that a “type” is defined as “one having the features of a class”. These concepts are interrelated, thus the “3 different types” must by definition define 3 different classes. The record before us does not mention nor address this in any way. We note that at page 9 of the reply brief the Appellant argues that type and class are different and the examiner has not addressed this argument.

Therefore, we request that the Examiner clarify the record on these points.

Accordingly, we *remand* for consideration of this issue.

III. Whether the rejection of claims 1, 80, 164, and 176 is a new ground of rejection.

In the answer the Examiner rejected claims 1, 80, 164, and 176 based on an explanation not found in earlier rejections. The record before us does not mention nor address in any way this change in the rejection. Therefore, we request that the Examiner clarify the record.

Accordingly, we *remand* for consideration of this issue.

IV. Whether the Examiner needs to more fully address each of the points raised by the *pro se* Appellant in the brief and reply brief.

In the brief, the Appellant raises approximately 20 points. The Examiner addresses some of these points in an abbreviated manner at pages 13-15 of the answer, and addresses about 12 of

the points in two groups at pages 15-18. For the first group the Examiner merely cites to the MPEP and for the second group the Examiner writes half a sentence at item 17 on page 18 of the answer. We do not find any indication in the record of why such abbreviated responses are appropriate for this *pro se* Appellant. We note that normally the practice of the Office is to provide a more complete explanation in pro se cases where the inventor is unfamiliar with patent law. See for example MPEP § 707. We request that the Examiner clarify the record.

Appellant raises 51 points in the reply brief, which the Examiner has noted and has not addressed. We have noted several of these points above at issues I and II. Additionally, it appears that each of the *pro se* Appellant's points beg for some response or clarification by the Examiner. We request that the Examiner provide a response to each of Appellant's points.

Accordingly, we *remand* for consideration of this issue.

Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the board following reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

This application, by virtue of its Special status, requires *immediate* action by the examiner. See MPEP § 708.01(d). The Board of Patent Appeals and Interferences *must* be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

Pertinent rules section

For Appellant's benefit we include a copy of new Patent Rule 37 CFR § 41.50 parts (a), (e), and (f) below which cover decisions and other actions by the Board. Of particular importance is section (a)(2) which sets forth Appellant's two options should the Examiner write a supplemental Examiner's answer in response to this remand. A complete copy of the patent rules can be found at http://www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf. We caution that this is a 334-page document and can require significant download time unless a broadband connection is available.

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. **The Board may also remand an application to the examiner.** (emphasis added)

(a)(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) Reopen prosecution. Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that

complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) Maintain appeal. Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

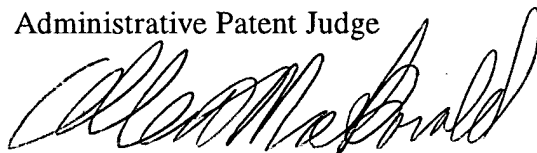
(e) Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

(f) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

REMAND



JOSEPH F. RUGGIERO
Administrative Patent Judge



ALLEN R. MACDONALD
Administrative Patent Judge



ROBERT E. NAPPI
Administrative Patent Judge

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